

**AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2616
PATENT
APPLICATION 10/748,959
ATTORNEY DOCKET 2003-0009 (1014-053)**

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1-3, 7-10, 19, and 20 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 is in independent form.

I. The Obviousness Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable over various combinations of WIPO Patent 01/17219 ("Hjartarson") and/or U.S. Patent 7,164,694 ("Nodoushani"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. *Prima Facie* Criteria for an Obviousness Rejection

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and

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4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). In *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007), the United States Supreme Court clarified that:

1. “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”;
2. “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”;
3. it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit”; and
4. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

To establish a *prima facie* case of obviousness, certain criteria must be met. Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). That evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. In addition, the prior art reference (or references when combined) must

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teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

3. Lack of Evidence of Reasons for Combining References

Under the *Graham* analysis, the "examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP 2142. The requirements for meeting this burden are clear.

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To factually support a *prima facie* conclusion of obviousness, an Office Action must provide evidence that indicates that the combination was obvious to a person with ordinary skill in the art. The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007) (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

4. The Applied Reference(s) Must Be Enabling

“In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.” *Rockwell Int'l Corp. v. U.S.*, 147 F.2d 1358, 47 USPQ2d 1027 (Fed. Cir. 1998); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1471, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

5. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

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B. Analysis

1. Claim 1

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

As an initial matter, the rejection of claim 1 is traversed as moot in view of the present amendments to claim 1. Specifically, claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to automatically substitute a Dolby Digital AC-3 codec for the G.722 codec responsive to a determination that customer premises equipment can accommodate Dolby Digital AC-3".

In addition, claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722". The present Office Action admits that this claimed subject matter is not taught by the applied portion of Hjartarson. The present Office Action asserts, at Page 3, "[h]owever, the background of Hjartarson recommends the codec instructions to be compatible with the ITU G.168 or similar standards, such as G.722." Applicant respectfully traverses this unsupported assertion since no evidence is of record that the G.722 standard (a speech codec standard) is "similar" in any way to "ITU G. 168" standard (an echo cancellation standard).

No substantial evidence has been presented that the applied portions of Nodoushani cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the

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Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

d. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered modification of Hjartarson, no evidence is provided whatsoever regarding why one having ordinary skill in the art would modify the applied portions of Hjartarson, that are used in rejecting claim 1 in such a manner so as to arrive at the claimed subject matter of claim 1. Regarding the proffered modification of Hjartarson the present Office Action states, at Page 3:

[t]he motivation for modifying the Hjartarson's method to be compatible with the ITU G or G.722 being that it will offer lower bit-rate compressions, as well as the ability to quickly adapt to varying compressions as the network topography mutates. Moreover, the modification will offer a significant improvement in speech quality over popular codecs.

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Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

e. Hjartarson Not Enabling

Claim 1, from which each of claims 2-18 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson enables, "the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722".

f. Conclusion

For at least these reasons, reconsideration and withdrawal of the rejection of claim 1 is respectfully requested. Also, reconsideration and withdrawal of each rejection of each of claims 2-18, each ultimately depending from independent claim 1, is respectfully requested.

2. Claim 2

Claim 2 states, *inter alia*, yet the applied portions of Hjartarson do not teach, "sampling the received analog signal into a plurality of samples". The present Office Action alleges that this claimed subject matter is inherently present in Hjartarson. To the extent that the present Office Action or future Office Actions rely upon inherency, Applicant respectfully requests provision of a reference demonstrating that the admittedly missing claimed subject matter is "necessarily present, not merely probably or possibly present, in the prior art." For at least these reasons, reconsideration and withdrawal of the rejection of claim 2 is respectfully requested.

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3. Claim 7

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

As an initial matter, the rejection of claim 7 is traversed as moot in view of the present amendments to claim 7. Specifically, claim 7, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to switch automatically between the codec specified in G.722 and a POTS codec based upon capabilities of customer premises equipment".

No substantial evidence has been presented that the applied portions of Nodoushani cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 7 is respectfully requested.

4. Claim 8

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

As an initial matter, the rejection of claim 8 is traversed as moot in view of the present amendments to claim 8. Specifically, claim 8 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to switch

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automatically between the codec specified in G.722 and a POTS codec based upon network capabilities".

No substantial evidence has been presented that the applied portions of Nodoushani cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach **every** limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 8 is respectfully requested.

5. Claim 9

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

As an initial matter, the rejection of claim 9 is traversed as moot in view of the present amendments to claim 9. Specifically, claim 9 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to encode the plurality of digital samples into an ADPCM format".

No substantial evidence has been presented that the applied portions of Nodoushani cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the

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Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach **every** limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 9 is respectfully requested.

6. Claim 10

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

As an initial matter, the rejection of claim 10 is traversed as moot in view of the present amendments to claim 10. Specifically, claim 10 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to encode the plurality of digital samples into an LD-CELP format".

No substantial evidence has been presented that the applied portions of Nodoushani cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach **every** limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

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For at least these reasons, reconsideration and withdrawal of the rejection of claim 10 is respectfully requested.

7. Claim 11

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Hjartarson with Nodoushani, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson and Nodoushani, that are used in rejecting claim 11 in such a manner so as to arrive at the claimed subject matter of claim 11. Regarding the proffered modification of Hjartarson the present Office Action states, at Page 6, "[t]he motivation for utilizing the conversion method taught by Nodoushani within the telecommunication system of Hjartarson being that it will allow the system to have a dedicated channel for control signals."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, reconsideration and withdrawal of the rejection of claim 11 is respectfully requested.

8. Claim 12

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Hjartarson with Nodoushani, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson and Nodoushani, that are used in rejecting claim 12 in such a manner so as to arrive at the claimed subject matter of claim 12. Regarding the proffered modification of Hjartarson the present Office Action states, at Page 6, "[t]he motivation for utilizing the conversion method taught by Nodoushani within the telecommunication system of Hjartarson being that it will allow the system to have a dedicated channel for control signals."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, reconsideration and withdrawal of the rejection of claim 12 is respectfully requested.

9. Claim 13

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Hjartarson with Nodoushani, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson and Nodoushani, that are used in rejecting claim 13 in such a manner so as to arrive at the claimed subject matter of claim 13. Regarding the proffered modification of Hjartarson the present Office Action states, at Page 6, "[t]he motivation for utilizing the conversion method taught by Nodoushani within the

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telecommunication system of Hjartarson being that it will allow the system to have a dedicated channel for control signals."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, reconsideration and withdrawal of the rejection of claim 13 is respectfully requested.

10. Claim 14

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Hjartarson with Nodoushani, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Hjartarson and Nodoushani, that are used in rejecting claim 14 in such a manner so as to arrive at the claimed subject matter of claim 14. Regarding the proffered modification of Hjartarson the present Office Action states, at Page 6, "[t]he motivation for utilizing the conversion method taught by Nodoushani within the telecommunication system of Hjartarson being that it will allow the system to have a dedicated channel for control signals."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*.

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Applicant reiterates that under *KSR* “rejections on obviousness grounds cannot be sustained by mere conclusory statements”.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 14 is respectfully requested.

11. Claim 19

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

As an initial matter, the rejection of claim 19 is traversed as moot in view of the present amendments to claim 19. Specifically, claim 19 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, “the line card adapted to automatically substitute a Dolby Digital AC-3 codec for the G.722 codec responsive to a determination that customer premises equipment can accommodate Dolby Digital AC-3”.

In addition, claim 19 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, “the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722”. The present Office Action admits that this claimed subject matter is not taught by the applied portion of Hjartarson. The present Office Action asserts, at Page 3, “[h]owever, the background of Hjartarson recommends the codec instructions to be compatible with the ITU G.168 or similar standards, such as G.722.” Applicant respectfully traverses this unsupported assertion since no evidence is of record that the G.722 standard (a speech codec standard) is “similar” in any way to “ITU G. 168” standard (an echo cancellation standard).

No substantial evidence has been presented that the applied portions of Nodoushani cure these deficiencies of the applied portions of Hjartarson.

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Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

d. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered modification of Hjartarson, no evidence is provided whatsoever regarding why one having ordinary skill in the art would modify the applied portions of Hjartarson, that are used in rejecting claim 19 in such a manner so as to arrive at the claimed subject matter of claim 19. Regarding the proffered modification of Hjartarson the present Office Action states, at Page 3:

[t]he motivation for modifying the Hjartarson's method to be compatible with the ITU G or G.722 being that it will offer lower bit-rate compressions, as well as the ability to quickly adapt to varying compressions as the network topography

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mutates. Moreover, the modification will offer a significant improvement in speech quality over popular codecs.”

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a “rational underpinning, to combine the known elements in the fashion claimed in the patent at issue”. Moreover, no evidence is presented that this unsupported assertion was “known in the prior art”, as required by *KSR*. Applicant reiterates that under *KSR* “rejections on obviousness grounds cannot be sustained by mere conclusory statements”.

e. Hjartarson Not Enabling

Claim 19 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson enables, “the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722”.

f. Conclusion

For at least these reasons, reconsideration and withdrawal of the rejection of claim 19 is respectfully requested.

12. Claim 20

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

As an initial matter, the rejection of claim 20 is traversed as moot in view of the present amendments to claim 20. Specifically, claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, “the line card adapted to

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automatically substitute a Dolby Digital AC-3 codec for the G.722 codec responsive to a determination that customer premises equipment can accommodate Dolby Digital AC-3".

In addition, claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson teach, "the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722". The present Office Action admits that this claimed subject matter is not taught by the applied portion of Hjartarson. The present Office Action asserts, at Page 3, "[h]owever, the background of Hjartarson recommends the codec instructions to be compatible with the ITU G.168 or similar standards, such as G.722." Applicant respectfully traverses this unsupported assertion since no evidence is of record that the G.722 standard (a speech codec standard) is "similar" in any way to "ITU G. 168" standard (an echo cancellation standard).

No substantial evidence has been presented that the applied portions of Nodoushani cure these deficiencies of the applied portions of Hjartarson.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

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Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

d. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered modification of Hjartarson, no evidence is provided whatsoever regarding why one having ordinary skill in the art would modify the applied portions of Hjartarson, that are used in rejecting claim 20 in such a manner so as to arrive at the claimed subject matter of claim 20. Regarding the proffered modification of Hjartarson the present Office Action states, at Page 3:

[t]he motivation for modifying the Hjartarson's method to be compatible with the ITU G or G.722 being that it will offer lower bit-rate compressions, as well as the ability to quickly adapt to varying compressions as the network topography mutates. Moreover, the modification will offer a significant improvement in speech quality over popular codecs."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

e. Hjartarson Not Enabling

Claim 20 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hjartarson enables, "the line card adapted to utilize an enhanced mode, the enhanced mode adapted to use a codec specified in G.722".

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f. Conclusion

For at least these reasons, reconsideration and withdrawal of the rejection of claim 20 is respectfully requested.

II. The Present Office Action Fails to Respond to All of Applicant's Arguments

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of Applicant's submitted arguments. *See MPEP 707.07(f).*

In response to an Office Action dated 15 June 2007, Applicant filed a proper Reply on 19 September 2007, which is incorporated herein by reference. In traversing a rejection of independent claim 2, Applicant presented the following argument that stands unopposed in the present Office Action:

[c]laim 2 states, *inter alia*, yet the applied portions of Hjartarson do not teach, "sampling the received analog signal into a plurality of samples". The present Office Action alleges that this claimed subject matter is inherently present in Hjartarson. To the extent that the present Office Action or future Office Actions rely upon inherency, Applicant respectfully requests provision of a reference demonstrating that the admittedly missing claimed subject matter is "necessarily present, not merely probably or possibly present, in the prior art."

The present Office Action fails to respond whatsoever to this previously presented and persuasive argument. Thus, Applicant respectfully requests the withdrawal of the rejections of claims 2.

III. The Finality of the Office Action is Improper, Premature, and should be Withdrawn

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of Applicant's submitted arguments. *See MPEP 707.07(f).*

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In addition, as indicated, *supra*, in response to the Office Action dated 15 June 2007, Applicant filed a proper Reply on 19 September 2007. In traversing a rejection of independent claim 2, Applicant presented the following argument that stands unopposed in the present Office Action:

[c]laim 2 states, *inter alia*, yet the applied portions of Hjartarson do not teach, "sampling the received analog signal into a plurality of samples". The present Office Action alleges that this claimed subject matter is inherently present in Hjartarson. To the extent that the present Office Action or future Office Actions rely upon inherency, Applicant respectfully requests provision of a reference demonstrating that the admittedly missing claimed subject matter is "necessarily present, not merely probably or possibly present, in the prior art."

The present Office Action fails to respond whatsoever to this previously presented and persuasive argument.

The Office Action dated 15 June 2007 purported, at Page 3, to only reject claims 1, 6, 19, and 20 under 35 U.S.C. 102(b). Yet, at pages 4 and 5 the Office Action dated 15 June 2007 appears to make additional rejections of each of claims 2-5, 7-10, and 15-18 under 35 U.S.C. 102(b). Applicant respectfully submits that this lack of clarity regarding at least the rejection of each of claims 2-5, 7-10, and 15-18 means that the rejections of the present Office Action of each of those claims represents a new grounds of rejection not necessitated by any claim amendment.

For at least these reasons, Applicant respectfully submits that the finality of the 27 November 2007 Office Action is premature. Thus, Applicant respectfully requests that the finality of the 27 November 2007 Office Action be withdrawn.

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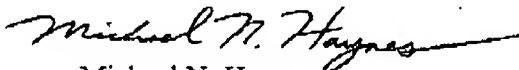
CONCLUSION

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Date: 21 January 2008

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